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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/722,870

11/26/2003

Marc Alan Strand

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06/13/2006

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EXAMINER

BOYKIN, TERRESSA M

ART UNIT

PAPER NUMBER

1711

DATE MAILED: 06/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/722,870

Applicant(s)

STRAND ET AL.

Examiner

Terressa M. Boykin

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1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4-3-6.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

Applicant's arguments filed 4-3-06 have been fully considered but they are not persuasive.

Applicants' claim 1 remains so broadly set forth that the claim continues to be interpreted by the Examiner as anticipated by the references while remaining within the scope of the specification. The composition basically consist of a polyester and an additive.

The fact that it may be used for calendering and that the additive prevent sticking may be an inherent property in literally thousands of polyesters although not mentioned or discussed. Any properties or characteristics inherent in the prior art, e.g. prevents sticking etc., although unobserved or detected by the reference, would still anticipate the claimed invention. Note In re Swinehart, 169 USPQ 226. "It is elementary that the mere recitation of a newly discovered...property, inherently possessed by things in the prior art, does not cause claim drawn to those things to distinguish over the prior art".

It should be noted that in order to prosecute the case resourcefully and expediently while giving the applicants the best possible search, it is imperative and practical for the applicants to clarify how the polyester containing an additive are arranged/incorporated/formed or structured therein.

Without such specificity or clarity of structure, the art of record (as well as several others) is within the scope of the present claims.

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* It would be beneficial and helpful for the applicants in order to expedite the prosecution of the case to be in position of allowability by using language from the specification or drawn directly from the examples of the specification that would clearly and further specify the claimed language without, of course, unfairly limiting applicants intended invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

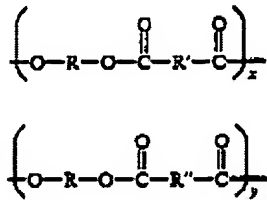
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-33 are rejected under 35 U.S.C. 103(a) as being unpatentable USP 5399661 see abstract, cols. 1-4, examples and claim 1.

The reference discloses a thermoplastic copolyester composition having improved ductility, mold flow, and rate of crystallization, and a melting point of about 161.degree. C. or higher, comprising the reaction product of (A) at least one alkane diol selected from the group consisting of straight chain, branched, and cycloaliphatic C2-C 10 alkane diols; (B) a mixture of at least two cycloaliphatic diacids; said mixture comprising from about 0.5 to about 49 parts by weight of a cis-enantiomer and from about 51 to about 99.5 parts by weight of a trans-enantiomer, the parts by weight of the cis-enantiomer and the trans-enantiomer being based upon 100 parts by weight of the cis- and trans-enantiomers combined; and (C) at least one aromatic diacid; wherein the molar ratio of cycloaliphatic diacid to aromatic diacid thereof ranges from 1:9 to 1:1,

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wherein said copolyester has recurring units of the formula



wherein R represents residue of the alkane diol, R' represents the decarboxylated residue derived from the cycloaliphatic diacids, and R'' represents an aromatic radical which is the decarboxylated residue of the aromatic diacid, and wherein the x units comprise from 10 to 90 parts by weight and the y units comprise from 90 to 10 parts by weight of 100 parts by weight of the copolyester.

Examples of suitable polyesters are linear saturated polyesters, which can be obtained either by polycondensation of a hydroxycarboxylic acid, or preferably, by synthesis from a dicarboxylic acid and a saturated diol. These include but are not limited to poly(butylene trans-1,4-cyclohexane dicarboxylate), poly(1,4-butylene terephthalate) and the like.

The polyester was molded and tested following the procedure of Example 1.

Again, as noted above, the actual composition as claimed consist of a polyester and an additive. The calendering may be considered a preamble and that the additive has the characteristic of preventing sticking may be an inherent property in many polyesters containing additives therein although not mentioned or discussed. The particular amount of residue does not seem to be the crux or invention part of the invention *as claimed* that may allegedly or subsequently

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affords the characteristic of nonstick etc.. Nevertheless, it would have been obvious to one having ordinary skill in the art at the time

the invention was made to employ both the claimed ranges of the specific weight percent of branching monomer residues as well as the specific range for the inherent viscosity. Applicants have provided no satisfactory results that would lend to an unobvious result of using the now narrowed claimed range of the branching agent. Further, one would have known to adjust the inherent viscosity according to the function of the intended composition since no unobvious result is connected thereto. Consequently, the claimed invention cannot be deemed as unobvious and accordingly is unpatentable.

Correspondence

Please note that the cited U.S. patents and patent application publications are available for download via the Office's PAIR. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site (www.uspto.gov), from the Office of Public Records and from commercial sources. Applicants may be referred to the Electronic Business Center (EBC) at <http://www.uspto.gov/ebc/index.html> or 1-866-217-9197.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Terressa Boykin whose telephone number is 571 272-1069. The examiner can normally be reached on Monday through Friday from 6:30am to 3:00pm.

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The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. The general information number for listings of personnel is (**571-272-1700**).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tmb


Examiner Terressa Boykin

**TERRESSA M. BOYKIN
PRIMARY EXAMINER**